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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,823	10/23/2001	Francesco G. Salituro	VPI/99-01 CON US	1783

7590 03/13/2003
VERTEX PHARMACEUTICALS INCORPORATED
130 Waverly Street
Cambridge, MA 02139-4242

EXAMINER

MCKENZIE, THOMAS C

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/13/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,823

Applicant(s)

SALITURO ET AL.

Examiner

Thomas McKenzie Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to an application filed on 10/23/01. There are thirteen claims pending. Claims 1-3 are compound claims. Claim 4 is a composition claim. Claims 5-13 are use claims. The application concerns some 3-oximino indole compounds, compositions, and uses thereof.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claim 3 and parts of 1, 2, and 4-13, drawn to 3-oximino indoles, compounds of formula I with A^1-A^4 = carbon and W = nitrogen, classified in class 548, subclass 483, among others.
- II. Claims parts of 1, 2, and 4-13, drawn to 3-amido benzimidazoles, compounds of formula II with A^1-A^4 = carbon and Z = nitrogen, classified in class 548, subclass 306.4, among others.
- III. Claims parts of 1, 2, and 4-13, drawn to 3-acyl indoles, compounds of formula I with A^1-A^4 = carbon and W = carbon, classified in class 548, subclass 486, among others.
- IV. Claims parts of 1, 2, and 4-13, drawn to 3-amido indoles, compounds of formula II with A^1-A^4 = carbon and Z = carbon, classified in class 548, subclass 486, among others.

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- V. Claim parts of 1, 2, and 4-13, drawn to 3-oximino pyrrolopyridines, compounds of formula I with at least one of A^1-A^4 = nitrogen and W = nitrogen, classified in class 546, subclass 113, among others.
- VI. Claims parts of 1, 2, and 4-13, drawn to 3-amido imidazolopyridines, compounds of formula II with at least one of A^1-A^4 = nitrogen and Z = nitrogen, classified in class 546, subclass 118, among others.
- VII. Claims parts of 1, 2, and 4-13, drawn to 3-acyl pyrrolopyridines, compounds of formula I with at least one of A^1-A^4 = nitrogen and W = carbon, classified in class 546, subclass 113, among others.
- VIII. Claims parts of 1, 2, and 4-13, drawn to 3-amido pyrrolopyridines, compounds of formula II with least one of A^1-A^4 = nitrogen and Z = carbon, classified in class 546, subclass 113, among others.

If Applicants chose any of Groups V-VIII, then further restriction will be required as to the number and positions of the additional nitrogen atoms.

3. The inventions are distinct, each from the other because of the following reasons: the heterocyclic core of the structure given in claim 1 is the ring of formula I or of formula II. This ring is a mandatory feature and ranges in number of possible nitrogen atoms from one to five. These multiple claimed rings are chemically non-equivalent and are not art-recognized as sharing the same

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biological properties. Inventions I-III, V, and VI have acquired a separate status in the art as shown by their different classification, thus the patent search required for Group I is not co-extensive with that required for Groups II-VIII. The basic names of these heterocyclic compounds differ, thus the literature search for these various species will be divergent. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

Although Groups III and IV and V, VII, and VIII share the same classification respectively, Applicants themselves consider these different heterocyclic cores by using different formulas to represent them. A reference against a compound of formula I would not be a reference against a compound II. Thus, the formulas are patentably distinct. In addition, the basic names of these heterocyclic compounds differ, thus the literature search for these various species will be divergent.

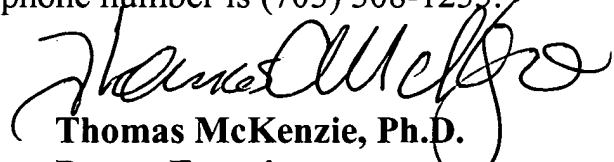
Should Applicants traverse the restriction requirement on the grounds that the different core rings are not patentably distinguishable, Applicants should identify such evidence now of record or submit any such evidence that shows the groups to be obvious variants. Such evidence may be used in a rejection under 35 USC 103(a) if the Examiner finds any of the Groups unpatentable over the prior art.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Conclusion

5. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (703) 308-9806. The FAX number for before final amendments is (703) 872-9306. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, you can reach the Examiner's supervisor, Mukund Shah at (703) 308-4716. Please direct general inquiries or any inquiry relating to the status of this application to the receptionist whose telephone number is (703) 308-1235.


Thomas McKenzie, Ph.D.
Patent Examiner
Art Unit 1624

TCMcK
March 10, 2003